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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,157	10/30/2001	Jian Chen	P1381R1C1P4	8259

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EXAMINER

JIANG, DONG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 04/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/000,157

Applicant(s)

CHEN ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 61-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED OFFICE ACTION

Applicant's election without traverse of Invention III, represented by the original claims 14-21, and of SEQ ID NO:6 in Paper No. 15, filed on 10 February 2003 is acknowledged. Applicant's amendment in paper No. 15 is acknowledged and entered. Following the amendment, claims 1-60 are canceled, and the new claims 61-66 are added.

Currently, claims 61-66 are pending and under consideration.

#### Formal Matters:

##### *Title*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the elected claims are directed.

##### *Priority*

According to the priority statement of 10/30/01, it appears that priority is being claimed to a large number of utility and provisional applications. These applications appear to be drawn to unrelated subject matter and are either not available for consideration or for which consideration to determine support for the instantly claimed subject matter would require an undue burden. Accordingly, the subject matter defined in claims 61-66 has an effective filing date of 8/24/00, that of the PCT application PCT/US00/23328.

Applicants are requested to provide the serial number and specific page number(s) of any parent application to which priority is desired which specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession and fully enabled of prior to 8/24/00.

#### Rejections Over Prior Art:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 61-66 are rejected under 35 U.S.C. 102(a) as being anticipated by Gorman et al, WO200042187.

Gorman discloses a polypeptide of human IL-174 having an amino acid sequence of SEQ ID NO:22. Gorman's polypeptide of SEQ ID NO:22 comprises amino acid residues 19-177 of SEQ ID NO:6 of the present invention with 100% identity (see computer printout of the search results). Further, the reference teaches antibodies to said polypeptide. Gorman's antibodies to IL-174 would most definitely bind to PRO10272 polypeptide of the present invention with the specificity because the only difference between the two polypeptides of the prior art and the present invention is that Gorman's IL-174 of SEQ ID NO:22 does not have the signal sequence which consist of residues 1-18 of SEQ ID NO:6 of the present invention. As such, Gorman's antibody anticipates claim 61 of the instant invention. Additionally, the reference teaches that said antibody can be a monoclonal antibody, a single chain antibody (page 51, the last paragraph), or a humanized antibody (page 55, lines 30-32); a pharmaceutical formulation comprising the antibody and a pharmaceutically acceptable carrier, wherein it is administered to the host to be treated (the paragraph bridging pages 58 and 59), indicating "therapeutically effective amount" would be administered. Thus, the reference anticipates claims 62-65. Finally, Gorman teaches a kit comprising compartments containing the antibody and instructions, and therefore, the reference also anticipates claim 66.

**Conclusion:**

No claim is allowed.

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**Advisory Information:**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 703-305-1345. The examiner can normally be reached on Monday - Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for the organization where this application or proceeding is assigned is 703-308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

A handwritten signature in cursive script that reads "Lorraine Spector". The signature is written in dark ink and is positioned above the printed name and title.

LORRAINE SPECTOR  
PRIMARY EXAMINER

Dong Jiang, Ph.D.  
Patent Examiner  
AU1646  
3/10/03